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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/372,365	08/11/1999	SATYAN G. PITRODA	2683/74619	1321
24628	7590	08/25/2006	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/372,365

Applicant(s)

PITRODA, SATYAN G.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 43-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 43-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the communication filed on May 11, 2006, which paper has been placed of record in the file.
2. Claims 1-11 and 43-51 are elected for consideration in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-11 and 43-51 have been considered but are moot in view of new grounds of rejections.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (hereinafter Goldhaber), U.S. Patent No. 5,855,008, in view of Pitroda, U.S. Patent No. 5,884,271.

Regarding to claim 1, Goldhaber discloses a service provider for administering an account for a client, comprising:

a computer, having a processor, a data storage medium, and a network port (figures 1, 8, column 9, lines 62-67 and column 14, lines 22-30; attention broker computer 106, network 102);

the storage medium configured to store the client's personal information, account information, and transactional information (figure 7 and column 12, lines 15-45; consumer database 120 includes contact information 122, account history information 125, interest profile information 124);

the processor configured to:

create a database of client information including the client's personal information, account information associated with the client (figure 7 and column 12, lines 15-45; consumer database 120 includes contact information 122, account history information 125, interest profile information 124);

designate as confidential a predetermined first portion of the database client information (column 12, lines 50-67; contact information 122 is confidential and equivalent to a predetermined first portion of the database);

designate as non-confidential a predetermined second portion of the database of client information non-confidential (column 13, line 35-column 14, lines 15; profile 124 may be non-confidential and equivalent to a predetermined second portion of the database);

provide the client with access to the predetermined first and second portions of the database of client information via the network port (column 19, lines 1-20).

provide a plurality of vendors with access to the predetermined second portion of the database of client information via the network port (column 13, lines 52-60 and column 21, lines 32-39; providing advertisers access to profile 124);

deny access for the plurality of vendors to the predetermined first portion of the database of client information (column 12, lines 62-67 and column 21, lines 40-50; deny access for advertisers to the contact information 122);

designate a selected vendor from the plurality of vendors (column 7, lines 1-10; select an offer from an advertisement);

provide the selected vendor with access to selected information from the predetermined first portion of the database of client information (column 12, lines 60-67 and column 21, lines 40-50; provide the selected advertiser to access the contact information).

Goldhaber does not disclose the database of client information includes account information corresponding to a plurality of accounts associated with the client, and transactional information corresponding to plurality of transactions conducted by the client. However, Pitroda discloses the database of client information includes account information corresponding to a plurality of accounts associated with the client, and transactional information corresponding to plurality of transactions conducted by the client (see abstract, a universal electronic transaction card ("UET card") is capable of serving as a number of different credit cards, bank cards, identification cards, employee cards, medical and health care management cards and the like. The UET card includes storage elements, an input interface, a processor, a display, and a communications

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interface. In a preferred embodiment, the UET card stores transactional information to eliminate paper receipts and includes security features to prevent unauthorized use. The UET card may also be used to replace conventional currency and traveler's checks, and may be configured to store and display promotional information, such as advertising and incentives.). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Goldhaber's to adopt the teaching of Pitroda above for the purpose of providing more efficiency in maintaining and tracking a plurality accounts of client.

Regarding to claim 2, Goldhaber further discloses the storage medium is further configured to store information corresponding to the plurality of vendors; and the processor is further configured to: create a database of vendor information; receive a transaction request from a client; analyze information in the database; analyze information in the database of vendor information; analyze information in the database of client information (figure 8 and column 14, lines 40-45; receiving the ad 68 and specified demographic information from the advertiser, comparing the specified demographic information with the interest profile and routing the ad 68 to only those consumers whose profiles match the demographics specified by advertiser). Goldhaber does not disclose provide a suggested transaction to the client based on the information in the database of vendor information and the database of client information. However, such feature is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Goldhaber's to

include well known feature above for the purpose of suggesting better transaction to the client.

Regarding to claim 3, Goldhaber further discloses the processor is further configured to: establish communication with a vendor via the network port; disclose information from the predetermined second portion of the database of client information to the vendor (figure 8 and column 14, lines 15-40; an advertiser 62 can access the profile 124); receive information from the vendor; provide information received from the vendor to the client (figure 8 and column 14, lines 40-45; receiving the ad 68 from the advertiser and routing the ad 68 to the consumer).

Regarding to claims 4 and 11, Goldhaber does not disclose the processor is further configured to: establish a communications with a service institution via the network port; receive transaction information corresponding to the client from the service institution; add the transactional information received from the service institution to the database of client information. However, Pitroda discloses the processor is further configured to: establish a communications with a service institution via the network port; receive transaction information corresponding to the client from the service institution; add the transactional information received from the service institution to the database of client information, reconcile the information received from the service institution with the information received from the client (column 16, line 50-column 17, line 38). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Goldhaber's to adopt the teaching of Pitroda above for the purpose of settlement the transaction for the client by communicating with the service institution.

Regarding to claim 5, Goldhaber further discloses the processor is further configured to: establish communication with the client via the network port; receive information from the client; and add the information received from the client to the database of client information (column 19, lines 1-20).

Regarding to claims 6-9, Goldhaber further discloses the information received from the client includes transaction information, personal information, account information, and promotional information (column 12, lines 20-38; column 15, lines 55-60).

Regarding to claim 10, Goldhaber further discloses the processor is further configured to establish communication with an electronic transaction device and transactional information is received from the electronic transaction device (figure 1 and column 12, lines 40-45; consumer's computer 104 is equivalent to the electronic transaction device).

Regarding to claims 43-45, Goldhaber further discloses the processor is further configured to: comprise a client data consolidation expert system, the client data consolidation expert system receiving input information comprising client profile information (column 12, lines 39-45), transaction and records analysis (column 6, lines 50-67), and privacy specifications (column 13, lines 15-35), suggest to the client at least one selected vendor from the plurality of vendors to designate for receiving access to selected information from the first portion of the database of client information; allow the client to designate for receiving access to selected information from the first portion of the database of client information (column 7, lines 1-10; select an offer from an

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advertisement; and column 12, lines 60-67 and column 21, lines 40-50; provide the selected advertiser to access the contact information).

6. Claims 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (hereinafter Goldhaber), U.S. Patent No. 5,855,008, in view of Pitroda, U.S. Patent No. 5,884,271, and further in view of Brandt et al (hereinafter Brandt), U.S. Patent No. 6,714,979.

Regarding to claim 46, Goldhaber discloses a service provider for administering a plurality of accounts for a client, comprising:

an electronic commerce server, having a processor, a data storage medium, and a network port (figures 1, 8, column 9, lines 62-67 and column 14, lines 22-30; attention broker computer 106, network 102);

the storage medium configured to store the client's personal information, account information, and transactional information (figure 7 and column 12, lines 15-45; consumer database 120 includes contact information 122, account history information 125, interest profile information 124);

the processor configured to:

create a database of client information including the client's personal information, account information (figure 7 and column 12, lines 15-45; consumer database 120 includes contact information 122, account history information 125, interest profile information 124);

allow the client to designate as confidential a predetermined first portion of the database client information (column 12, lines 50-67; contact information 122 is confidential and equivalent to a predetermined first portion of the database);

allow the client to designate as non-confidential a predetermined second portion of the database of client information non-confidential (column 13, line 35-column 14, lines 15; profile 124 may be non-confidential and equivalent to a predetermined second portion of the database);

provide the client with access to the predetermined first and second portions of the database of client information via the network port (column 19, lines 1-20).

provide a plurality of vendors with access to the predetermined second portion of the database of client information via the network port (column 13, lines 52-60 and column 21, lines 32-39; providing advertisers access to profile 124) while deny access for the plurality of vendors to the predetermined first portion of the database of client information (column 12, lines 62-67 and column 21, lines 40-50; deny access for advertisers to the contact information 122).

Goldhaber does not disclose the database of client information includes account information corresponding to a plurality of accounts associated with the client, and transactional information corresponding to plurality of transactions conducted by the client. However, Pitroda discloses the database of client information includes account information corresponding to a plurality of accounts associated with the client, and transactional information corresponding to plurality of transactions conducted by the client (see abstract, a universal electronic transaction card ("UET card") is capable of serving as a number of different credit cards, bank cards, identification cards, employee cards, medical and health care management cards and the like. The UET card includes storage elements, an input interface, a processor, a display, and a communications interface. In a preferred embodiment, the UET card stores transactional information to

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eliminate paper receipts and includes security features to prevent unauthorized use.

The UET card may also be used to replace conventional currency and traveler's checks, and may be configured to store and display promotional information, such as advertising and incentives.). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Goldhaber's to adopt the teaching of Pitroda above for the purpose of providing more efficiency in maintaining and tracking a plurality accounts of client.

Goldhaber does not teach an internal server, including an internal database, the internal server configured to perform backend processing; and a firewall separating the internal server from the electronic commerce server. However, Brandt teaches an internal server, including an internal database, the internal server configured to perform backend processing; and a firewall separating the internal server from the electronic commerce server (figure 6; column 10, line 60-column 67; the firewall 55(b) separating the MCI Intranet Midrange Servers 60 (internal server) from the Web server 44 (electronic commerce server). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Goldhaber's for the purpose of improving security in order to prevent unauthorized users to access to the secure web server.

Regarding to claims 47-48, Goldhaber further discloses the client identifying information comprises the name and a telephone number associated with the client (column 13, lines 1-10).

Regarding to claim 49, Goldhaber further discloses the processor is further configured to: comprise a client data consolidation expert system, the client data consolidation expert system receiving input information comprising client profile information (column 12, lines 39-45), transaction and records analysis (column 6, lines 50-67), and privacy specifications (column 13, lines 15-35).

Regarding to claims 50-51, Goldhaber does not teach the electronic commerce server and the internal server are physically and logically separate servers. However, Brandt teaches the electronic commerce server and the internal server are physically and logically separate servers (figure 6; column 10, line 60-column 67; the firewall 55(b) separating the MCI Intranet Midrange Servers 60 (internal server) from the Web server 44 (electronic commerce server). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Goldhaber's for the purpose of improving security in order to prevent unauthorized users to access to the secure web server.

Conclusion

7. Claims **1-11 and 43-51** are rejected.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner Nga B. Nguyen, whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9. Any response to this action should be mail to:

Commissioner of Patents and Trademarks
c/o Technology Center 3600
Washington, D.C. 20231

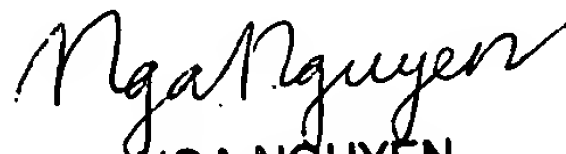
or faxed to:

(703) 872-9306, (for formal communications intended for entry)

or:

(571) 273-0325 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Knox building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).


NGA NGUYEN
PRIMARY EXAMINER

July 20, 2006